

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:
Dettinger et al.

Serial No.: 10/664,537

Filed: September 19, 2003

For: EXPANDING THE SCOPE OF
AN ANNOTATION TO AN
ENTITY LEVEL

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Confirmation No.: 4274

Group Art Unit: 2168

Examiner: Cheyne D. Ly

MAIL STOP APPEAL BRIEF - PATENTS
Commissioner for Patents
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June 15, 2007
Date

/Esther Marques/
Esther Marques

Dear Sir:

APPEAL BRIEF

Applicants submit this Appeal Brief to the Board of Patent Appeals and Interferences on appeal from the decision of the Examiner of Group Art Unit 2168 dated January 19, 2007, finally rejecting claims 1-5 and 20-28. The final rejection of claims 1-5 and 20-28 is appealed. This Appeal Brief is believed to be timely since it is electronically transmitted by the due date of June 19, 2007, as set by the filing of a Notice of Appeal on April 19, 2006. Please charge the fee of \$500.00 for filing this brief to Deposit Account No. 09-0465/ROC920030157US1.

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Real Party in Interest

The present application has been assigned to International Business Machines Corporation, Armonk, New York.

Related Appeals and Interferences

Applicant asserts that no other appeals or interferences are known to the Applicant, the Applicant's legal representative, or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

Status of Claims

Claims 1-5 and 20-28 are pending in the application. Claims 1-38 were originally presented in the application. No claims have been added during prosecution. Claims 6-21 and 29-38 have been canceled without prejudice. Claims 1-5 and 20-28 stand finally rejected as discussed below. The final rejections of claims 1-5 and 20-28 are appealed. The pending claims are shown in the attached Claims Appendix.

Status of Amendments

All claim amendments have been entered by the Examiner. No amendments to the claims were proposed after the final rejection.

Summary of Claimed Subject Matter

A. CLAIM 1 – INDEPENDENT

Claim 1 recites a method of exchanging information via an annotation. See *Application*, page 4: lines 26-27; 17: 21-24; Figure 3A, 300; Figure 3B, 350. The method includes providing an interface allowing a first user to view query results including one or more data objects the first user is authorized to view. See *Application*, 4: 27-28; 17: 4-8; 18: 5-6; Figure 4A, 401. The user is then allowed to select a data object from the query results, and create an annotation with a scope encompassing the selected data object. See *Application*, 4: 28-29; 17: 12-13; 18: 7-11; Figure 4A, 402, 406, 408.

As claimed, the operations also include providing an interface element allowing the first user to expand the scope of the annotation to encompass one or more data objects the first user is not authorized to view. See *Application*, 4: 29-31; 17: 8-14; 20: 21-29; Figure 4B, 410, 416.

B. CLAIM 20 - INDEPENDENT

Claim 20 recites a tangible computer-readable storage medium containing a program for exchanging information via an annotation. See *Application*, page 5: 8-9; 17: 21-24; Figure 3A, 300; Figure 3B, 350. The program provides an interface allowing a first user to view query results including one or more data objects the first user is authorized to view. See *Application*, 5: 10-11; 17: 4-8; 18: 5-6; Figure 4A, 401. The user is then allowed to select a data object from the query results, and create an annotation with a scope encompassing the selected data object. See *Application*, 5: 11-13; 17: 12-13; 18: 7-11; Figure 4A, 402, 406, 408.

As claimed, the operations also include providing an interface element allowing the first user to expand the scope of the annotation to encompass one or more data objects the first user is not authorized to view. See *Application*, 5: 13-15; 17: 8-14; 20: 21-29; Figure 4B, 410, 416.

Grounds of Rejection to be Reviewed on Appeal

1. Rejection of claims 1-4 and 20-24 under 35 U.S.C. 103(a) as being unpatentable over *Evans* (U.S. Patent No. 5,924,074, hereinafter, "*Evans*") taken with *Palomo et al.* (U.S. Publication 2003/0120527, hereinafter, "*Palomo*").

2. Rejection of claims 5 and 25-28 under 35 U.S.C. 103(a) as being unpatentable over *Evans* taken with *Palomo* as applied to claims 1-4 and 20-24 above, and further in view of *Clark et al.* (U.S. Patent No. 5974389, hereinafter, "*Clark*").

ARGUMENTS

Rejection of claims 1-4 and 20-24 under 35 U.S.C. 103(a) over *Evans* taken with *Palomo*.

The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. See MPEP § 2142. To establish a *prima facie* case of obviousness three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one ordinary skill in the art to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP § 2143. The present rejection fails to establish at least the third criterion.

Claims 1 and 20 Are Not Obvious under 35 U.S.C. § 103(a) over Evans taken with Palomo.

Regarding claims 1 and 20, the Examiner takes the position that *Evans* teaches “providing an interface element allowing the first user to expand the scope of the annotation to encompass one or more data objects” at column 8, lines 19-60. Specifically, the Examiner maintains that the teaching of *Evans* that “the patients data structure includes pointers to data structures having data within a patient record captured by the point of care system and incorporated from external sources,” is expanding the scope of annotations. However, the cited paragraph is not directed towards expanding the scope of annotations. In fact, the cited paragraph does not deal with annotations at all. *Evans*’ patient data structure merely links patient names and ID numbers with their medical data. See *Evans*, column 8, lines 29-47. This data (patient names, ID numbers, and medical data) are not annotations. While this data may possibly have annotations associated with them, the patient data structure is not expanding the scope of these possible annotations in any way. Thus, the patient data structure is in fact just a method to link various medical data to a specific patient. The patient data structure does nothing with annotations of data. Therefore, the patient data

structure does not expand the scope of an annotation to encompass one or more data objects (whether or not the user has authorization to view the data objects). Accordingly, withdrawal of this rejection is respectfully requested.

Furthermore, Applicants note that, even if assuming, *arguendo*, a progress note is an annotation, it does not follow that using a pointer to link the note to another note constitutes expanding the scope of the note. The reference, on column 8, lines 45-50, teaches that the links connect a note to reference structures; there is nothing about scope or expansion. Accordingly, the cited passage does not teach “providing an interface element allowing the first user to expand the scope of the annotation to encompass one or more data objects” and withdrawal of this rejection is respectfully requested.

In the Advisory Action the Examiner asserts that the above arguments are not found persuasive because the current application’s specification does not explicitly define the limit of “annotation.” Consequently, the Examiner claims to attribute annotation with its customary and ordinary meaning as understood by one of ordinary skill in the art. Applicants respectfully note that the specification of the current application clearly states that annotations are used to capture tacit knowledge. See *Application*, page 2, lines 1-2 (annotations); page 1, line 20 through page 2, line 6 (generally).

Furthermore, the Examiner is inconsistent with the application of the term “annotation” within *Evans*. Specifically, column 7, lines 5-39, is cited by the Examiner to read on another element that includes annotation. Annotations are explicitly mentioned in the cited passage of *Evans*, and Applicants readily concede that the term is used in this cited passage in the same way as in the current application (i.e., as recordings of tacit knowledge). See also, *Evans*, Figure 7, 174 (figure and item explained on column 7, lines 12-17). The Examiner then cites column 8, lines 38-44 of *Evans*, and asserts that it also reads on a claimed element that includes annotations:

The patient data structure 210 likewise maintains pointers to a clinical data structure 212, a progress note structure 213 and an encounter data structure

214. These data structures include patient data captured by the clinical data capture 142, progress notes 144 and counter data capture 146, respectively (FIG. 4).

This second passage clearly contains no mention of annotations and does not contain any language that even alludes to annotations, as disclosed by *Evans* and employed by the Examiner elsewhere on column 7, lines 5-39. Nor does this passage refer to any structure that comports with Applicants' definition of annotation. Thus, this portion of *Evans* (i.e., column 8, lines 38-44) does not teach an annotation as defined either by *Evans* itself, or by the Applicants specification, or according to any other reasonable definition. Accordingly, the cited passage does not teach "providing an interface element allowing the first user to expand the scope of the annotation to encompass one or more data objects" and withdrawal of this rejection is respectfully requested.

Claim 20 has similar limitations and therefore is allowable for all or some of the reasons given above.

Accordingly, withdrawal of this rejection is respectfully requested.

Claims 2-4 Are Not Obvious under 35 U.S.C. § 103(a) over Evans taken with Palomo.

Claims 2-4 depend from independent claim 1, and are therefore believed to be allowable for the reasons provided above. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 21-24 Are Not Obvious under 35 U.S.C. § 103(a) over Evans taken with Palomo.

Claims 21-24 depend from independent claim 20, and are therefore believed to be allowable for the reasons provided above. Accordingly, withdrawal of this rejection is respectfully requested.

Rejection of claims 5 and 25-28 under 35 U.S.C. 103(a) over *Evans* taken with *Palomo*, and further in view of *Clark*.

The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. See MPEP § 2142. To establish a *prima facie* case of obviousness three

basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one ordinary skill in the art to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP § 2143. The present rejection fails to establish at least the third criterion.

Claims 5 and 25, 27, and 28 Are Not Obvious under 35 U.S.C. § 103(a) over Evans taken with Palomo, and further in view of Clark.

The Examiner maintains that *Clark* teaches “displaying, to the second user, an indication of the annotation.” See *Clark*, column 9, lines 32-45. However, the cited passage does not mention annotations anywhere. Instead, it is directed to viewing a patient’s chart that has been filled out with contact data. Contact data is something that can, in principle, be annotated, but is not itself an annotation. Thus, *Clark* does not disclose “displaying, to the second user, an indication of the annotation.”

Claims 25, 27, and 28 have similar limitations and therefore are allowable for the same reason given above.

Accordingly, withdrawal of this rejection is respectfully requested.

Claim 26 Is Not Obvious under 35 U.S.C. § 103(a) over Evans taken with Palomo, and further in view of Clark.

As an initial matter Applicants respectfully note that, while the Examiner issued a categorical rejection of claim 26, the claim is never specifically rejected. Accordingly, the rejection is defective. See, MPEP §707.07 (d) stating that omnibus rejections should be avoided and that a plurality of claims should never be grouped together in a common rejection unless that rejection is equally applicable to all claims in the group. In this case, claim 26 recites an additional element not found in claims 25, 27 and 28. Accordingly, absent a separate basis for rejecting claim 26 over the art, the rejection is defective. Accordingly, Applicants respectfully request that the rejection be withdrawn.

CONCLUSION

The Examiner errs in finding that:

1. Claims 1-4 and 20-24 are unpatentable over *Evans* taken with *Palomo*.
2. Claims 5 and 25-28 are unpatentable over *Evans* taken with *Palomo*, and further in view of *Clark*.

Withdrawal of the rejections and allowance of all claims is respectfully requested.

Respectfully submitted, and
S-signed pursuant to 37 CFR 1.4,

/Gero G. McClellan, Reg. No. 44,227/

Gero G. McClellan
Registration No. 44,227
Patterson & Sheridan, L.L.P.
3040 Post Oak Blvd. Suite 1500
Houston, TX 77056
Telephone: (713) 623-4844
Facsimile: (713) 623-4846
Attorney for Appellants

CLAIMS APPENDIX

1. (Previously Presented) A method of exchanging information via an annotation, comprising:
 - providing an interface allowing a first user to view query results including one or more data objects the first user is authorized to view, select a data object from the query results, and create an annotation with a scope encompassing a selected data object; and
 - providing an interface element allowing the first user to expand the scope of the annotation to encompass one or more data objects the first user is not authorized to view.
2. (Previously Presented) The method of claim 1, wherein providing an interface element allowing the first user to expand the scope of the annotation comprises providing an interface element allowing the user to associate the annotation with a primary key for a row of data containing the selected data object.
3. (Previously Presented) The method of claim 1, wherein providing an interface allowing a first user to view query results and create an annotation with a scope related to the selected data object comprises:
 - providing an interface allowing the first user to select one or more rows, columns, or cells of the query results; and
 - providing an interface allowing the first user to create an annotation for the selected one or more rows, columns, or cells.
4. (Previously Presented) The method of claim 1, wherein:
 - providing an interface element allowing the first user to expand the scope of the annotation comprises allowing the first user to associate the annotation with a model entity encompassing the selected data object the first user is authorized to view as well as data objects the first user is not authorized to view; and
 - the method further comprises storing the annotation with a reference to the model entity.

5. (Previously Presented) The method of claim 1, further comprising:
providing an interface allowing a second user to view query results including one or more data objects the first user is not authorized to view that are encompassed by the expanded scope of the annotation; and
providing an indication to the second user, in the interface, an indication of the annotation.

6-19. (Canceled)

20. (Previously Presented) A tangible computer-readable storage medium containing a program for exchanging information via annotations which, when executed by a processor, performs operations comprising:

providing an interface allowing a first user to view query results, select a data object from the query results, and create an annotation with a scope encompassing a selected data object that the first user is authorized to view; and

providing an interface element allowing the first user to expand the scope of the annotation to encompass one or more data objects the first user is not authorized to view.

21. (Previously Presented) The tangible computer-readable storage medium of claim 20, wherein providing an interface element allowing the first user to expand the scope of the annotation comprises providing an interface element allowing the first user to associate the annotation with a primary key for a row of data containing the selected data object.

22. (Previously Presented) The tangible computer-readable storage medium of claim 21, wherein:

providing an interface element allowing the first user to expand the scope of the annotation comprises allowing the first user to associate the annotation with an entity encompassing the selected data object and one or more data objects that the first user is not authorized to view; and

the method further comprises storing the annotation with a reference to the entity.

23. (Previously Presented) The tangible computer-readable storage medium of claim 22, wherein:

allowing the first user to associate the annotation with an entity comprises presenting the first user with one or more entities encompassing the selected data object and one or more data objects that the first user is not authorized to view; and

the method further comprises storing the annotation with a reference to at least one of the one or more entities selected by the user.

24. (Previously Presented) The tangible computer-readable storage medium of claim 20, wherein the selected data object is an instance value of a field encompassed by an entity.

25. (Previously Presented) The tangible computer-readable storage medium of claim 24, wherein the operations further comprise:

displaying second query results to a second user including one or more data objects the first user is not authorized to view which are encompassed by the expanded scope of the annotation, wherein at least a portion of the second query results are associated with the entity; and

displaying, to the second user, an indication of the annotation.

26. (Previously Presented) The tangible computer-readable storage medium of claim 25, wherein the second query results do not contain the selected data object described by the annotation.

27. (Previously Presented) The tangible computer-readable storage medium of claim 25, wherein the operations further comprise, in response to input from the second user, displaying the annotation to the second user.

28. (Previously Presented) The tangible computer-readable storage medium of claim 27, wherein the operations further comprise displaying, to the second user, the selected data object described by the annotation.

29-38. (Canceled)

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

None.